

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Michael Krebs**

Confirmation No.: **3301**

Serial No.: **10/822,625**

Group Art Unit: 1762

Filing Date: **April 12, 2004**

Examiner: **Patrick Dennis Niland**

For: **Reactive Polyurethane Compositions With A Low Residual Monomer Content**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellants submit this Reply in response to the Examiner's Answer dated January 7, 2011 in connection with the above-identified application. This Reply is being filed within two months of the Examiner's Answer.

In the Appeal Brief, Appellants detailed arguments concerning the (i) solid versus liquid nature of polyols, (ii) aromatic polyol component, (iii) cancellation of polyether polyol language from component "b" in the claims, and (iv) content of aromatic diisocyanate. Any one of these arguments differentiates the instant invention from the cited art. In view of the Examiner's Answer, Applicant's Reply addresses several statements related to the solid versus liquid nature of the polyols. The following arguments are designed to supplement, not replace the arguments presented in the Appeal Brief.

The Claims Meet the Written Description Requirement

Contrary to the Examiner's position, the specification does support the recitation in claim 1 that the polyester-polyols are "solid at room temperature". See, Examiner's Answer at pages

3-4 and 22-23. As is well known, “[t]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). *See*, MPEP § 2163.02. Appellants submit that the original specification provides sufficient written description to satisfy this standard.

For example, the original specification defines “polyols” as “polyether-polyols, polyalkylene diols and/or *crystalline, partly crystalline or vitreously amorphous polyester-polyols*, and *optionally liquid* polyester-polyols.” *See*, the original specification at paragraph 0023 on page 7 (emphasis added). Thus, polyester polyols can be *crystalline, partly crystalline or vitreously amorphous polyester-polyols*. Appellants further note that this designation is distinct from liquid polyester polyols in the definition (*id.*). The specification further defines “[s]olid at room temperature” as meaning “the composition is *crystalline, partly crystalline and/or vitreously amorphous* and has a softening point above 23°C (by the ring and ball method).” *See*, the original specification at paragraph 0020 on page 7. As such, polyester is defined by the same words as used in the “solid at room temperature” definition.

The Examiner, however, asserts that the “solid at room temperature” definition in paragraph 0020 of the specification applies only to the adhesive composition as a whole and does not apply to polyester polyols. *See*, Examiner’s Answer at pages 3-4 and 22-23. In making this distinction, the Examiner points to paragraph 0019 of the specification which is said to discuss the composition as a whole. Appellants agree that paragraph 0019 discusses the composition as a whole. This paragraph is the first paragraph of the Detailed Description and defines the invention broadly. Paragraph 0020 defines a term, i.e., “solid at room temperature,” used in paragraph 0019 but does not limit the definition to that context. Looking at the overlapping language between this definition and the language used to describe the polyols clearly supports Appellants interpretation. The narrow interpretation put forth by the Examiner is contrary to the teachings of the specification. As noted above, the polyols are defined by the very words of the “solid at room temperature” definition. As such, and contrary to the Examiner’s allegation, there is sufficient support to recite the polyester polyol as “solid at room temperature.” Appellants

submit that the Examiner's rejection should be withdrawn. Accordingly, the incorporation of the term "solid at room temperature" into the definition of the polyester polyol in the instant claims clearly distinguishes from the teachings of the 493 patent which uses polyols that are liquid at room temperature. *See*, column 5, lines 33-38 of the 493 patent.

Improper Entry of Evidence by the Examiner (and Lack of Relevance)

On pages 28-31 of the Examiner's Answer, the Examiner describes personal observations concerning a beaker of polymer that the Examiner assumed to be solid but was later observed to be a viscous liquid. This evidence was not previously made of record. Appellants believe that such evidence should be entered, if at all, via affidavit from the Examiner in accordance with 37 C.F.R. § 1.104(d)(2) or should not be part of the record.

That being said, Appellants submit that the above-noted evidence presented by the Examiner is not relevant to the patentability question at issue. In particular, Appellants note that the argument is not congruent with the claim scope. The claims are directed to use of polyester polyols that are solid at room temperature, not polyester polyols that appear to be solid at room temperature. The line of reasoning put forth by the Examiner seems to be part of an overall argument that nothing is what it appears to be, e.g.: it may look solid but it is a liquid (pages 28-31 of the Examiner's Answer); or all polymers have some amorphous character, even with solid polymers (Examiner's Answer at pages 11-12). However, the plain language of claim 1 is "solid at room temperature". As discussed above and in the Appeal Brief, the cited art teaches the element to be "liquid." The terms "solid" and "liquid" do have meaning and are not deemed equivalent for purposes of interpreting the claims in view of the cited art.

Conclusions

Appellants believe that each of the arguments put forth in the Appeal Brief, on their own or in combination, are sufficient to overcome the Examiner's rejections. As presented herein, at least one clear line of demarcation of the instant claims from the cited art is the difference

between solid and liquid polyester polyols. The feature "solid at room temperature" is fully supported by the specification, and such a feature is not taught or suggested by the cited art.

Respectfully submitted,

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